

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the amendments and the following discussion, is respectfully requested.

Claims 16-27 and 34-36 are pending in this case. Claims 16 and 22 are amended by the present amendment with support in the originally filed disclosure at least at paragraphs [0004] and at paragraphs [0068] to [0071]. Thus, no new matter is added.

The outstanding Office Action rejected Claims 16-27 and 34-36 under 35 U.S.C. § 103(a) as unpatentable over Kolls (U.S. Patent No. 6,615,183) in view of Short (U.S. Patent No. 6,462,839).

Applicant respectfully traverses the rejection of the pending claims.

Amended Claim 16 recites an image forming apparatus comprising, *inter alia*, “**a communications mechanism, within the image forming apparatus, configured to communicate with a banner advertiser terminal via a network**” and “**a displaying mechanism configured to display, within the image forming apparatus, a banner advertisement**, stored in the banner advertisement storage unit, offering at least one of a product and services.”

The outstanding Office Action asserts Kolls as teaching every element of Claim 16 except “display, within the image forming apparatus,” which it asserts Short as teaching. Specifically, the outstanding Office Action asserts, at page 2, that “Short teaches a displaying mechanism that is configured to display on a single body of an image forming apparatus,” and cites column 2, lines 51-52 and 61-62, of Short.

However, while the cited portion of Short and Short, generally, describes a combined printer and scanner with a pivotable mechanism for the scanner door, nothing in Short teaches or suggests “**a communications mechanism, within the image forming apparatus, configured to communicate with a banner advertiser terminal via a network**” or “**a**

**displaying mechanism configured to display, within the image forming apparatus, a banner advertisement.”**

Further, as discussed in previous responses, the system 500 of Kolls, depicted at Fig. 3B of Kolls, for example, is not part of an image forming apparatus. Thus, Koll's description of display or communication by the system 500 does not teach or suggest “a communications mechanism, within the image forming apparatus” or “a displaying mechanism...within the image forming apparatus.”

As the discussion above sets out, neither Kolls nor Short teaches or suggests “a communications mechanism, within the image forming apparatus” or “a displaying mechanism...within the image forming apparatus.” Yet, the outstanding Office Action asserts that the combination of Kolls and Short teaches the features that are deficient in both references and states that “[i]t is obvious to follows convention,” and asserts that Short teaches that placing all the components into or on a single body is “conventional.”

However, an image forming apparatus including “a communications mechanism, within the image forming apparatus” and “a displaying mechanism...within the image forming apparatus,” as defined by Claim 16, is not conventional, and the outstanding Office Action has not provided any rationale for concluding that it is.

As set out by MPEP § 2143 and reiterated by the Court recently, a **“patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”** Emphasis added. KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385, 1389 (2007). The Court stated the importance of identifying “a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does” and noted, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)), **“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”** Emphasis added.

In this case, Applicant first reiterates that the outstanding Office Action is not even asserting a combination of elements, because at least two of the elements of Claim 16, as discussed above, are not taught by either Kolls or Short.

Further, the outstanding Office Action fails to provide both the necessary modification that accounts for a complete and proper integration of the elements of the cited references, as required by MPEP § 706.02(V), and the necessary rationale for the asserted combination, as discussed above.

Finally, when both the claimed invention and Kolls are considered as a whole, as required by MPEP § 2141, Kolls evidences a teaching away from “a communications mechanism, within the image forming apparatus” and “a displaying mechanism...within the image forming apparatus,” as defined by Claim 16. Kolls is directed to an electronic commerce terminal that can be connected to one or several machines, as shown at Figures 3B to 3E. An integration of the system 500 into a single machine, even if properly and fully described by another reference, would reduce the flexibility of the system described by Kolls.

Because Kolls and Short, even in combination, does not teach or suggest at least the features of Claim 16 discussed above, Applicant respectfully requests that the rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Claims 22 and 34-36, though differing in scope and statutory class from Claim 16, patentably define over the combination of Kolls and Short for similar reasons as those discussed with respect to Claim 16, because Claims 22 and 34-36 recite at least display/displaying “within the image forming apparatus.” Thus, Applicant respectfully requests that the rejection under of Claims 22 and 34-36 under 35 U.S.C. § 103(a) be withdrawn.

Claims 17-21 depend from Claim 16, and Claims 23-27 depend from Claim 22. Thus, Claims 17-21 and 23-27 patentably define over the combination of Kolls and Short for at

least the same reasons as Claims 16 and 22. Further, Claims 17-21 and 23-27 define additional features that are also deficient in the combination of Kolls and Short.

For example, Claim 19 recites the image forming apparatus further comprising “**a downloading mechanism configured to download a return message in a printable form from the banner advertiser terminal in response to the at least one of the order and the inquiry** for the at least one of the product and the services sent by the response sending mechanism.”

The previous Office Action asserted the transaction receipt printing described at column 17, lines 50-55, of Kolls as teaching the above-quoted features of Claim 19.

However, in context, the cited description is clearly of a transaction receipt for a transaction at a machine, such as the printer 612A. That is, the transaction would be a user using the printer 612A and receiving a receipt for the fee associated with the use. Such a use of the machine as a vended machine does not teach or suggest downloading “**a return message in a printable form from the banner advertiser terminal in response to the at least one of the order and the inquiry**,” at least because the system 500 that is attached to the printer 612A and displaying an advertisement cannot also be asserted as a banner advertisement terminal, as discussed in previous responses.

Claim 25 recites an image forming apparatus further comprising “downloading means for **downloading a return message in a printable form from the banner advertiser terminal in response to the at least one of the order and the inquiry** for the at least one of the product and the services sent by the response sending means.”

As discussed above, the transaction receipt described by Kolls fails to teach or suggest “downloading a return message in a printable form from the banner advertiser terminal,” as recited by Claim 25.

Thus, Applicant respectfully requests that the rejection of Claims 17-21 and 23-27 under 35 U.S.C. § 103(a) be withdrawn.

If a rejection of the pending claims is maintained based on Kolls and/or Short, Applicant requests that each of the arguments herein be specifically addressed in a subsequent Action.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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